

REMARKS

At the outset, Applicants wish to thank Examiner Ke for the courtesies extended to Applicants' undersigned representative at the October 31, 2007, telephone interview. During the interview, Applicants discussed whether the finality of the previous Office Action was proper. Examiner Ke appeared to agree that the finality was premature, but asked that the issue be raised in this paper for more consideration. Applicants submit the present paper to address this issue, as well as additional issues, and requests that if subsequent rejections are made, that the rejections be made non-final so that Applicants may have an opportunity to respond.

Claims 1-3, 5-15 and 18-31 remain pending in this application. In the Office Action, claims 1-3, 5-15 and 18-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over an alleged four-way combination of Ermel et al. (U.S. Patent No. 5,835,094), Edelman et al. (U.S. Patent No. 5,680,563), Mander et al. (U.S. Patent No. 6,243,724) and Ulrich et al. (U.S. Patent No. 6,466,227). This rejection is respectfully traversed below, especially insofar as it may be applied to the claims as amended.

I. Improper Final

Applicants respectfully submit that the Office Action was improperly made final. Specifically, a new ground of rejection (adding Ulrich et al.) was applied against independent claim 13, but that new ground could not have been necessitated by the previous amendment. The prior amendment to claim 13 only added language from dependent claim 17 and intervening claim 16 (canceling claims 16 and 17), and did not introduce any new features beyond what was already in claim 17. The new ground of

rejection is different from what was originally applied against claim 17, and could not have been necessitated by the amendment. During the interview, Examiner Ke noted that he would likely reissue the rejection as a non-final rejection. Applicants respectfully request such treatment, so that Applicants may have a fair opportunity to respond to the new ground of rejection.

Furthermore, the Office Action does not address many of the substantive points that Applicants raised in the June 22, 2007, Amendment, and simply repeats its prior rejections and commentary (e.g., its reliance on Mander et al. to reject several of the claims). Some of these points are reiterated below, and Applicants submit that these points need to be addressed on the merits before the case is truly ready for appeal.

II. Independent Claim 1, and Dependent Claims 2-3, 5, 7-12 and 29

Independent claim 1 recites, among other features, “comparing the stack size with a predefined range of stack icon sizes, wherein said range is subdivided into at least three stack size sub-ranges” and “identifying one of the sub-ranges into which the determined stack size falls.” The Office Action concedes that Ermel et al. and Edelman et al. fail to teach or suggest such a feature, and alleges that Mander et al. and Ulrich et al. combine to teach such a feature. Applicants respectfully disagree.

The Office Action primarily relies on Mander et al. for this feature. However, and as Applicants noted in the June 22, 2007, Amendment, Mander et al. does not compare a stack size with a predefined range of stack icon sizes, and identify a sub-range into which the determined stack size falls. Mander et al. does not need any such predefined range, comparison or identification, since all documents in the Mander et al.

pile are shown in the pile icon. Indeed, Mander et al. expressly favors having each document represented individually in the pile icon, so that the user can move a cursor up or down over the pile icon to select a particular document in the pile based on where the cursor is in relation to the pile. See, e.g., col. 10, lines 4-20. Mander et al. fails to teach or suggest comparing a stack size with a predefined range of stack sizes, and identifying one of the sub-ranges into which the determined stack size falls, as recited.

The Office Action cites two specific portions of Mander et al. for this predefined range, and Applicants submit that neither of these portions teaches or suggests the recited features. First, the “Create and Display Pile” step of Figure 19 is part of a general process of searching documents (which is described beginning at col. 32, line 33). As described in Mander et al., the user first enters the search terms (e.g., by specifying a set of terms, or entering a document vector) and weights, and the system then displays the search results. The Mander et al. user has the option of choosing a sample document as the basis for the search, and in the cited step, the search results are sorted based on the ones that are closest to the sample document (see col. 33, lines 15-17). Nowhere in this discussion is there any teaching or suggestion of “comparing the stack size with a predefined range of stack icon sizes, wherein said range is subdivided into at least three stack size sub-ranges”; and “identifying one of the sub-ranges into which the determined stack size falls,” as recited.

The second cited portion comes from Figure 20, and specifically in steps 955 and 963. In those portions, Mander et al. describes color-coding the pile so that documents are colored according to some criteria, such as the date. Again, what is the “predefined

range of stack icon sizes” in this section? Applicants submit that there is no teaching or suggestion here of such a predefined range of stack icon sizes.

The newly-cited Ulrich et al. reference does not overcome this deficiency. Ulrich et al. describes desktop themes for a graphical user interface (GUI), and in the cited Fig. 2C, Ulrich et al. shows that one ‘Look and Feel’ option allows the user to choose from three icon sizes (e.g., small, medium and large) to be used in the ‘List View.’ There is no teaching or suggestion that these icon sizes correspond in any way to the stack size of a plurality of files that are to be represented by a stack icon. Instead, the sizes appear to simply allow the user to choose one default size for all displayed items. There is still no comparing a stack size with a predefined range of stack sizes, and identifying one of the sub-ranges into which the determined stack size falls, as recited.

Claims 2-3, 5, 7-12 and 29 depend from claim 1, and are distinguishable for at least the same reasons as claim 1, and further in view of the various features recited therein. For example, claim 5 recites wherein one of the sub-ranges is a maximum range identified by a minimum size, and the identifying one of the sub-ranges includes determining whether the determined stack size exceeds said size minimum. To show such a maximum range identified by a minimum size, the Office Action cites Mander, Fig. 18b, in its subpiles. Figure 18b is described beginning at col. 31, line 13, and in that description, the user is permitted to identify the number of subpiles that are to be created from an original pile. There is no teaching or suggestion of what, if anything, is the alleged “maximum range identified by a minimum size,” or of “determining whether the determined stack size exceeds said size minimum.” Indeed, the description there makes

no mention at all of any size minimums or maximums. Applicants pointed this out in the June 22, 2007, Amendment, but the Office Action offers no response.

III. Independent Claim 13, and Dependent Claims 14, 15, 18-22 and 30-31

Independent claim 13 recites, among other features “assigning a first size range to a first one of said predefined stack icons.” The Office Action cites the Mander et al. pile for this feature. What is the alleged size range assigned to a first one of the predefined stack icons? Since, as discussed above, Mander et al. dynamically edits its pile icons to increase or decrease in size as documents are added/removed, there is no such size range assigned to a predefined stack icon, as recited.

Claim 13 also recites “assigning a minimum size to a third one of said predefined stack icons, said third one of said predefined stack icons being a maximum size icon.” The Office Action cites Mander et al. for this feature. As Applicants asked in the June 22 Amendment, what is the alleged minimum size of Mander et al.’s alleged maximum size icon? The Office Action does not offer any more information on this rejection. What is Mander et al.’s maximum size icon? Mander et al. dynamically changes its pile icon, and there is no teaching or suggestion of a minimum size of a maximum size icon.

Claim 13 also recites “step of selecting comprises the step of comparing a size of said plurality of files with said first range or said minimum size.” The Office Action cites the same Mander et al. pile height change discussed above, but there is still no explanation of how, or why, Mander et al. would even do such a selecting. Mander et al. does not disclose comparing a size of a plurality of files with a first range or a minimum size. The dynamic adjustment of Mander et al.’s pile height simply increases or

decreases the height with each document added or removed – no comparison is shown or needed in Mander et al.'s system.

For at least these reasons, amended claim 13 distinguishes over the art of record, and is in condition for allowance. Claims 14-15, 18-22 and 30-31 depend from claim 13, and are distinguishable for at least the same reasons as claim 13, and further in view of the various features recited therein. .

IV. Independent Claim 23 and Dependent Claims 24-28

Independent claim 23 recites, among other features, “comparing the stack size to a plurality of stack size boundaries that divide a stack size range into three or more sub-ranges.” The Office Action still fails to identify any such boundaries. The Office Action cites Mander et al. again, but does not identify where in Mander et al. any such boundaries are shown. What are the alleged Mander et al. boundaries? As noted above, the Mander et al. pile height simply increases or decreases by one for each file that is added or removed from the pile, and no such boundaries are used.

For at least these reasons, amended independent claim 23 is distinguishable over the cited references. Claims 24-28 depend from claim 23, and are distinguishable for at least the same reasons as claim 23, and further in view of the features recited therein. For example, claim 24 recites that each stored set of default icons comprises a plurality of stack icons, each icon corresponding to a different range of stack sizes. None of the cited references discloses such icons corresponding to a different range of stack sizes.

V. Conclusion

For at least the above reasons, Applicants submit that the pending claims are distinguishable over the art of record, and are in condition for allowance. However, if the Examiner feels that additional discussion and/or amendment would be helpful, the Examiner is invited to telephone Applicants' undersigned representative at the number appearing below.

Respectfully submitted,

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